

REMARKS

The last Office Action has been carefully considered.

It is noted that Claims 1-8 and 12 are rejected under 35 USC 103(a) over the U.S. patent application publication to DeDaran et al in view of the U.S. application publication to Anthony.

Claims 9-10 are rejected under 35 USC 103(a) over the DeDaran and Anthony references, and further in view of the French patent to Migne.

Claim 11 is rejected over the DeDaran and Anthony references and further in view of the U.S. patent to Honl et al.

Also, the disclosure and the claims are objected to.

In connection with the Examiner's objection to the disclosure and the claims, the disclosure and the claims have been amended correspondingly. It is believed that the grounds for the formal objections are therefore eliminated.

Are carefully considering the Examiner's grounds for rejection of the claims over the art, applicant cancelled Claim 4 and introduced its features into Claim 1, the broadest claim on file.

It is respectfully submitted that the new features of the present invention which are now defined in amended Claim 1 are not disclosed in the references applied by the Examiner against the original claims and should be considered as obvious from them.

In the Examiner's opinion the Anthony reference disclosed a ground face that is electrically connected via through-plated holes or via holes (through-hole plating 2020 of apertures 2018 disclosed in paragraph 109) to the ground terminals of the capacitors. The Examiner's opinion is not correct.

In the Anthony reference, Figures 12 and 13 in connection with paragraphs 107 and 108, it is disclosed that the top and sides of the carrier 2010 are covered by metalized ground surface 2016. Isolated from this ground surface 2016, there are two apertures 2018, each surrounded by a conductive pad 2024. Between these conductive pads 2024 and the metalized ground surface 2016, there are located insulating bands 2022. The filter 2012 includes first and second differential electrode bands 2028 and 2030, which are electrically connected to the conductive pads 2024.

In addition, extending from the center of the filter 2012, there is at least one and more typically two common ground conductive bands 2026, coming in contact with a portion of the metalized ground surface 2016, which separates both the insulating bands 2022 from one another.

While Figures 14 and 15 show two different layers, where the metalized ground surface 2016 covers substantial portions of the top, sides and bottom of a double-sided carrier 2040, it is still not disclosed here that the common ground surfaces 2026 of Figures 2012a and 2012b are connected via through-plated holes or via-holes to the metalized ground surface 2016. Instead, they are electrically connected directly to them, since due to the fact that the ground surface 2016 is located on both sides of the carrier 2024, there is absolutely no necessity in using such thru-holes for a ground connection. The through-hole plating 2020 of apertures 2018 mentioned by the Examiner and disclosed in paragraph 109 are therefore not used for such a ground connection, but for the two differential electrode bands 2028 and 2030 respectfully.

The Anthony reference neither shows nor suggest that a ground face of a printed surface board is electrically connected via through-plated holes or via-holes to the ground terminal of a capacitor.

The DeDaran reference applied by the Examiner in combination with the Anthony reference also does not teach the above-mentioned new features of the present invention.

The original Claims were rejected over the combination of these two references as being obvious and therefore unpatentable under 35 USC 103(a). As explained hereinabove, the reference do not disclose the new features of the present invention as defined now in amended Claim 1 and they do not provide any hint or suggestion for such features. In order to arrive at the applicant's invention as defined in amended Claim 1 from the references, the references have to be fundamentally modified by including into them the new features of the present invention as defined in amended Claim 1. However, it is known that in order to arrive at a claimed invention, by modifying the references the cited art must itself contain a suggestion for such a modification.

This principle has been consistently upheld by the U.S. Court of Customs and Patent Appeals which, for example, held in its decision *In Re Randol and Redford* (165 USPQ 586) that:

Prior patents are references only for what they clearly disclose or suggest, it is not a proper use of a patent as a reference to modify its structure to one which prior art references do not suggest.

As for the Migne and Honl et al references, they also do not disclose the new features of the present invention as defined in amended Claim 1 and therefore any discussions thereof would be superfluous.

Claim 1 should be considered as patentably distinguishing over the art and should be allowed.

As for the dependent claims, these claims depend on Claim 1, they share its allowable features, and they should be allowed as well.

Reconsideration and allowance of the present application is most respectfully requested.

Should the Examiner require or consider it advisable that the specification, claims and/or drawings be further amended or corrected in formal respects in order to place this case in condition for final allowance, then it is respectfully requested that such amendments or corrections be carried out by Examiner's Amendment, and the case be passed to issue. Alternatively, should the Examiner feel that a personal discussion might be

helpful in advancing this case to allowance, he is invited to telephone the undersigned (at 631-549-4700).

Respectfully submitted,

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